

Applicant attempted to call Stan Silverman and left voicemail messages for him. Stan Silverman left return voicemail messages and in the last voicemail on January 26, 2007 indicated that he would not give an interview and that we should appeal the case. On January 26, 2007 Applicant's counsel then filed a written request for an interview. No response was given to the written request. On February 6, 2007 Applicant's counsel called the Examiner and he indicated that he would give an interview but Stan Silverman would not. Applicant's counsel indicated that this was unfair because we did not understand Stan Silverman's position. The Examiner indicated that he would relay Mr. Silverman's position in the interview. The Examiner indicated that Applicant must show unexpected superior results to Plzak's results and that we should do so in a declaration.

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Remarks

Applicant wishes to rely on its argument set forth in previous Amendment After Final filed on December 20, 2006 for the proposition that the Examiner has not met his burden and established a prima facie case of obviousness and will not reiterate it again in its entirety at this time.

a. Not all limitations shown and Unexpected results not necessary

Applicant can only assume that the Office is requiring unexpected results because it feels that this case is analogous to a situation where an applicant is claiming a range within the disclosure of the prior art. The Office is indicating that the only difference between the prior art and the claimed invention is the size of the catalyst. This is factually incorrect. The claims also

require an activation step which is not shown in the prior art. Therefore, the Office is incorrect in its assumption and its conclusion that unexpected results must be shown.

MPEP 2144.04(IV)(A) states as follows:

In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

If a change in dimensions that does not change the performance of the device renders the invention obvious then the contrary proposition should also be true. If a change in dimensions changes the performance of an invention then the invention should be nonobvious. This is the exact scenario for the Applicant's method. Applicant's claims require a different size for the catalyst. In order for the Applicant's device to work an activation step is required. This activation step is not required or disclosed by Plzak.

b. Unexpected Results


However even assuming that the Office is correct and unexpected results are required, Applicant has shown them.

Absence of property which a claimed invention would have been expected to possess based on the teachings of the prior art is evidence of unobviousness. *Ex parte Mead Johnson & Co.* 227 USPQ 78 (Bd. Pat. App. & Inter. 1985) (Based on prior art disclosures, claimed compounds would have been expected to possess beta-andrenergic blocking activity; the fact that claimed compounds did not possess such activity was an unexpected result sufficient to establish unobviousness within the meaning of 35 U.S.C. 103.).

Joe Pugach's Declaration indicates that a person of ordinary skill in the art reading Plzak would expect the oxidation to occur within 2 hours of the catalyst being placed within the reactor. Page 2 Paragraph 6. Joe Pugach supports this assertion by using the results table in Plzak as evidence. The Plzak table indicates that the reaction rates occur within 2 hours. Joe Pugach's Declaration indicates that the Applicant's catalyst would not work in 2 hours and only water is produced. Page 2 Paragraph 6. Therefore, Applicant has an absence of a property which the claimed invention would have been expected to possess, based on the teachings of the prior art and therefore has unexpected results and is nonobvious over Plzak.

Additionally, Joe Pugach's Declaration indicates that Plzak uses a method as described in Applied Catalysis A: General and is labled as Comparison Example 1 in Plzak. Comparison Example 1 within Plzak has a conversion rate of 1.14 which is unsatisfactory. Plzak examples 1 and 2 have conversion rates of 5.7 and 4.6. Joe Pugach's Declaration indicates that Applicant's method provides for the same conversion rate whether using the method described by Plzak Comparison Example 1 or the other Plzak examples. Therefore, again Applicant's results are different.

Respectfully submitted,

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